

c.) Remarks

The Patent Office objected to the drawings. Amended Fig. 1 and new Fig. 2 are submitted with this response. Care has been taken not to introduce new matter.

Claims 1-27 are pending in this application. Claims 4-5, 9, 15, 19, 21 have been canceled. Claims 28-32 are new. Claims 1-3, 6-8, 10, 12-14, 16-18, 20, 22-23, 26-27 have been amended in various particulars as indicated hereinabove.

1. Turning now to the merits, Claims 1, 2, 5-7, 8, 12, 13, 15, and 19-25 were rejected under 35 U.S.C. 102(b) over U.S. Patent 5,866,784 to Engelhardt (“Engelhardt”). Applicant respectfully asserts that the referenced Claims as amended are not anticipated by Engelhardt.

It is well established that a claim is anticipated under 35 U.S.C. §102, only if each and every element of the claim is found in a single prior art reference.<sup>1</sup> Moreover, to anticipate a claim under 35 U.S.C. §102, a single source must contain each and every element of the claim “arranged as in the claim.”<sup>2,3</sup> Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference.<sup>4</sup> If each and every element of a claim is not found in a single reference, there can be no anticipation.

Applicant asserts that Engelhardt does not teach a moveable single detector and a moveable optical element which can change their position relative to each other. In Engelhardt, different portions of the spectral region are detected by a different steady detector located in the appropriate position to sense the appropriate portion of the spectral region. For example, two detectors are necessary to sense two portion of the spectral region, as shown in Fig. 5 of Engelhardt. If a different portion of the spectral region

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<sup>1</sup> *Veregal Bros. v Union Oil Co. of California*, 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987).

<sup>2</sup> *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

<sup>3</sup> *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q. 2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988).

<sup>4</sup> *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

needs to be sensed, then the arrangement in Engelhard teaches to use a third detector, disposed apart from the first and second detectors, to sense that portion, as shown in Fig. 4. Also, in Engelhardt the prism is rotated pivotally to shift the portion of the spectral region that impinges on detector 26.

Turning now to the invention claimed in amended independent Claims 1, 8, and 12, Applicant respectfully points out that sensing a different portion of the spectral region is accomplished by either changing the position of only the single moveable detector, or a moveable optical element, which is a separate and different from the prism, or both. Such elements of the invention cannot be found in Engelhard and, therefore, the rejection should be withdrawn. Claims 2 and 6-7 depend off now allowable independent Claim 1, claim 10 depends off now allowable Claim 8, and claims 13, and 20-25 depend off now allowable independent Claim 12. Allowance of the above-referenced Claims is hereby requested.

2. Claims 9, 10, and 14 were rejected under 35 U.S.C. 102(e) over U.S. Patent 6,483,103 to Engelhardt, Hay and Hoffman. Claim 9 was cancelled. Applicant respectfully points out that U.S. Patent 6,483,103 to Engelhardt, Hay and Hoffman cannot be used for a rejection under 102(e), because Applicant **invented** the present claimed invention before the effective date of U.S. Patent 6,483,103 to Engelhardt, Hay and Hoffman.

The German priority application DE 100 38 049.2 was filed on August 2, 2000, which is before the February 15, 2001 effective filing date of U.S. Patent 6,483,103 to Engelhardt, Hay and Hoffman. Under 35 U.S.C. 104, prior invention can be established in a WTO country, if the invention was made after December 8, 1993. Clearly, filing of a German patent application in Germany on August 2, 2000, proves that the Applicant invented the present invention at least as of the German filing date. Proof of that German filing date was submitted in this case on August 28, 2001, when a certified copy of German priority application DE 100 38 049.2 was filed. Therefore, in accordance with 35 U.S.C. 104, the established date of invention is at least as early as August 2, 2000,

predating the February 15, 2001 effective filing date of U.S. Patent 6,483,103 to Engelhardt, Hay and Hoffman. Therefore, U.S. Patent 6,483,103 to Engelhardt, Hay and Hoffman should be withdrawn as a 102(e) reference in the case. Allowance of Claims 10 and 14 is respectfully requested.

3. Claims 16-18 were rejected under 35 U.S.C. 102(a) over U.S. Patent 5,866,784 to Engelhardt (“Engelhardt”). Claims 26-27 were rejected under 35 U.S.C. 102(a) over U.S. Patent 5,866,784 to Engelhardt (“Engelhardt”) in further view of U.S. Patent 6,462,345 to Simon (“Simon”). Applicant respectfully asserts that the referenced Claims as amended are not obvious over Engelhardt for reasons stated in section 1.

For an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case of obviousness. The Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the cited publications, which must have a suggestion, teaching or motivation for one of ordinary skill in the art to modify a reference or combined references.<sup>5</sup> The cited publications should explicitly provide a reasonable expectation of success, determined from the position of one of ordinary skill in the art at the time the invention was made.<sup>6</sup>

It is respectfully asserted that none of the cited patents, alone or in combination with the other one, teaches, suggests or hints to an optical arrangement in a confocal microscope in which sensing a different portion of the spectral region is accomplished by either changing the position of only one moveable detector, or a moveable optical element different from a prism, or both, as claimed in amended independent Claim 12. Such elements of the invention are not taught, or hinted to, or suggested in Engelhardt. No motivation to modify the device to come up with the invention claimed in independent Claim 12 could be found in Engelhardt alone or in combination with Simon.

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<sup>5</sup> *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

<sup>6</sup> *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970);

*Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996);

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Since Claims 16-18 and 26-27 depend off independent Claim 12, they cannot be obvious in view of Engelhardt and should be allowed.

Applicant also believes that the Claims as amended are in compliance with the requirements of 35 U.S.C. 112, second paragraph, as well as the informal transmission typos.

Applicant believes that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is strongly encouraged to contact the undersigned to discuss the pending Claims.

Respectfully submitted,

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